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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,997	05/23/2001	Lyle W. Shaw	F-167	1864

919 7590 12/01/2005

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,997

Applicant(s)

SHAW ET AL.

Examiner

CHAN S. PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

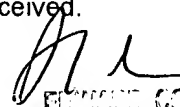
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
EDMUND COLLINS  
SENIOR PATENT EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/05 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 9/16/05, and has been entered and made of record. Currently, **claims 1-3 and 6-9** are pending.

### ***Claim Objections***

3. Claim 6 is objected to because of the following informalities:

Line 5, "the mailpiece" should be -- a mailpiece --;

Line 6, insert -- the -- between "head" and "first marking"; and

Line 6, "a mailpiece" should be -- the mailpiece --;

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noy et al. U.S. Patent No. 5,730,533 (hereinafter Noy) in view of Ohno U.S. Patent No. 5,933,676.

4. With respect to claim 1, Noy discloses a system for printing markings along a top and a bottom of a paper (fig. 2) comprising:

a print head in a fixed position, where the print head receives print instructions and prints both a first and a second set of the markings on the paper (col. 5, lines 1-6);

a memory containing data representative the first and second markings, the first markings associated with a first orientation, the second markings associated with a second orientation (col. 4, lines 5-15);

a print module, coupled to the memory and to the print head, for reading the data representative of the first set of markings from the memory, and converting the data to print instructions that instruct the print head to print the first set of markings onto the paper having the first orientation (col. 4, lines 5-15);

an inverted print module, coupled to the memory and to the print head, for reading the data representative of the second set of markings from the memory, and converting the data to print instructions that instruct the print head to invert the second

set of markings on the print head during printing onto the paper disposed in a second orientation which is inverted about 180 degrees with respect to the first orientation of the paper (col. 5, lines 1-6 & lines 27-29); and

a control module, coupled to the print module and the inverted print module, for sending marking requests to either the print module or the inverted print module, the marking requests indicating which data representative of the first or second sets of markings that are to be read from the memory, by the print module or the inverted print module, based on whether the paper is in the first or second orientation (col. 4, lines 16-29).

Noy, however, does not disclose explicitly that the printing system can be used in printing on a mailpiece (col. 3, lines 51-58).

Ohno, the same field of endeavor of the double-sided printing art, discloses a printing system for printing print data on a mailpiece (col. 6, line 51 – col. 7, line 15).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the printing system of Noy in printing print data on a mailpiece.

The suggestion/motivation for doing so would have been to prevent the printing system from printing the print data on the mailpiece in an undesired orientation.

Therefore, it would have been obvious to combine Noy with Ohno to obtain the invention as specified in claim 1.

5. With respect to claim 3, Noy discloses the system wherein the first and second sets of markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (fig. 2).

6. With respect to claim 6, Noy teaches a method for printing along tops and bottoms of mixed papers comprising:

associating first markings with a first paper orientation (col. 4, lines 31-39);

associating second markings with a second paper orientation (col. 4, lines 46-52);

transporting a paper in the first orientation (col. 4, lines 16-29);

printing, with a fixed print head, the first markings on a first set of the paper, the paper being transported in the first orientation (col. 4, lines 16-29);

reorienting the paper to the second orientation which is about 180 degrees from the first orientation (col. 4, lines 16-29);

transporting the paper in the second orientation (col. 4, lines 16-29); and

printing on a second side of the mailpiece, with the fixed print head, the second markings that are rotated on the print head about 180 degrees from the first orientation of the paper (col. 5, lines 27-29).

Noy, however, does not disclose explicitly that the printing system can be used in printing on a mailpiece (col. 3, lines 51-58).

Ohno, the same field of endeavor of the double-sided printing art, discloses a printing system for printing print data on a mailpiece (col. 6, line 51 – col. 7, line 15).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the printing system of Noy in printing print data on a mailpiece.

The suggestion/motivation for doing so would have been to prevent the printing system from printing the print data on the mailpiece in an undesired orientation.

Therefore, it would have been obvious to combine Noy with Ohno to obtain the invention as specified in claim 6.

7. With respect to claim 9, Noy teaches the method wherein the markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (fig. 2).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Noy and Ohno as applied to claim 1 above, and further in view of Oshima et al. U.S. Patent No. 5,932,139 (hereinafter Oshima).

8. With respect to claim 2, the combination discloses the system of claim 1, further comprising a scanning for capturing image data from the paper (reading of barcode in Noy) but it does not disclose expressly a scanner for capturing image data from the mailpiece and an optical character recognition, coupled to the scanner and to the control module, for converting the image data to computer data, where the control module queries a second memory for instructions as to what first set markings and/or second set of markings are related to the image data.

Oshima, the same field of endeavor of the printing, discloses a system comprising:

- a scanner for capturing image data from the mailpiece; and
- an optical character recognition, coupled to the scanner and to a control module, for converting the image data to computer data, where the control module queries a

memory for instructions as to what barcode information (marking) are related to the image data (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Noy and Ohno.

The suggestion/motivation for doing so would have been to provide a printer that can print the postal barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 2.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Noy and Ohno as applied to claim 6 above, and further in view of Oshima.

9. With respect to claim 7, the combination teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more first markings based upon the address information.

Oshima, the same field of endeavor of the printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more first markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).



At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Noy and Ohno.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 7.

10. With respect to claim 8, the combination teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more second markings based upon the address information.

Oshima, the same field of endeavor of the printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more second markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Noy and Ohno.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 8.

**Contact Information**

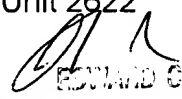
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
November 25, 2005

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
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